REMARKS/ARGUMENTS

At page 2, section 2(i), of the Office Action, the Examiner objected to Applicants' disclosure as originally filed because the "DETAILED DESCRIPTION OF THE INVENTION" section of the contains significant amount of prior art contents. The Examiner then requires that all the known prior art contents from the "DETAILED DESCRIPTION OF THE INVENTION" section be moved into the "Description of the Related Art" sub-section of the "BACKGROUND OF THE INVENTION" section. Applicants respectfully traverse this objection.

With due deference, discussions of prior art in the "detailed description" sections of U.S. patents and patent applications are commonplace. A general discussion of the prior art at the outset of the "detailed description" of the invention of a patent or patent application is routinely used to place an invention in technological context with respect the state-of-the-art. It also serves to establish a salient and readily intelligible contrast between the invention disclosed in the application and the prior art. Indeed, U.S. Patent No. 6,108,700 to Maccabee et al. relied upon by the Examiner in rejecting several of Applicants' claims offers a "prior art" discussion at the beginning of its "detailed description" section. The Examiner will note that the USPTO did not find that disclosure to be unacceptable.

Moreover, carving out such a substantial portion of the content from the remainder of the "detailed description" of the

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invention with which it is so entwined and thereafter integrating that material seamlessly into another section of the application is not a simple act of word processing. If not performed with the utmost care, the very content and integrity of the original disclosure could be compromised. It also would be needlessly time consuming. Thus, unless the Examiner can clearly demonstrate that the present disclosure is nonenabling or otherwise fatally defective in its present form, Applicants respectfully decline to amend the specification in the manner suggested by the Examiner.

At page 2, section 2(ii), of the Office Action, the Examiner objected to Applicants' disclosure by suggesting that Applicants are in some way withholding relevant prior art. The Examiner is reminded that, pursuant to their duty of disclosure under 37 C.F.R. § 1.56, Applicants submitted an Information Disclosure Statement (IDS) concurrently with filing of the present application. The Examiner will note that the references cited in the IDS (copies of which were enclosed with the IDS) are discussed in great detail in the specification. Accordingly, Applicants believe they have already fully complied with the Examiner's requirement that they provide the title, citation and copy of each publication that was a source used for the description of the prior art in the disclosure.

At page 2, section 3, of the Office Action, the Examiner objected to the title of the invention as allegedly being "not descriptive." Applicants disagree. As a proposed alternative title, the Examiner suggested a lengthy title that Applicants

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believe is overly detailed and directed to limited instantiations of the invention. For example, the first paragraph of the "SUMMARY OF THE INVENTION" section at page 6 of applicants' specification makes it clear that the "computer systems" that may be monitored by the present invention may range from a single computer to an end-to-end network computer system. The Examiner's suggested title relates only to "end-to-end network computer systems regardless of network topology" (emphasis added). Accordingly, as a compromise, Applicants offer the new title of the invention set forth hereinabove. Acceptance of that title is respectfully requested.

At page 3, section 4, of the Office Action, the Examiner objected to the Abstract. Responsive thereto, Applicants have provided a new Abstract that eliminates language objected to by the Examiner, includes prominent features of the invention and sets forth the goals/advantages of the invention. Acceptance of the new Abstract is therefore respectfully requested.

At page 4, section 6, of the Office Action, the Examiner rejected claim 8 under 35 U.S.C. § 112, first paragraph, as being nonenabling. Specifically, the Examiner objected to the language in claim 8 that refers to the agent measuring processing time "at each component of said computer system." Responsive thereto, independent claim 6, from which claim 8 depends, has been amended herein to state that the computer system to be monitored by the API according to the present invention comprises "at least one component" thereby establishing the clear antecedent basis required by the

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Examiner. Also, express support for the functionality of the agent called for in claim 8 is found at the first complete paragraph on page 15 of the specification. Accordingly, withdrawal of the outstanding Section 112, first paragraph, rejection of claim 8 is respectfully requested.

At page 4, section 8, of the Office Action, the Examiner rejected claims 1, 2, 6 and 7 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,633,908 ("Leymann"). Such rejection is respectfully traversed.

As amended herein, each of independent claims 1, 6 and 9 now expressly state that software code is added to the computer application being monitored by the API of the present invention to assign a single general reference to characteristic transactional information associated with a computer application transaction under surveillance. In stark contrast, Leymann does so by way of a separate application invocation agent. The following passages from the Leymann patent underscore the differences between his invocation agent based method of operation and the Applicants' invention:

> The basic idea of the present invention is to instrument not the application components. The present invention contemplates instrumenting the invocation agent instead, which in turn is responsible for calling the application for execution.

Leymann at col. 7, line 66, through column 8, line 1 (emphasis added).

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The present invention relates to the area of systems management teaching means and a method for determining and managing application performance. Application Response Measurement (ARM) assumes that the managed application is a self-instrumented component. This requires invasive changes to existing applications or to add explicitly code to newly written applications. Due to this additional effort this will restrict the area of applicability of ARM. <u>The basic idea of the present invention is to instrument not the application components. The present invention contemplates instrumenting the invocation agent instead, which in turn is responsible to call the application for execution. This solution provides application response measurement without any modification of the application being measured.</u> It is the invocation agent that makes the appropriate ARM calls to furnish the instrumentation on behalf of the application.

Leymann at Abstract(emphasis added).

Leymann is thus diametrically opposed in architecture and operation to the system and method recited in Applicants' independent claims. Consequently, Leymann neither anticipates, suggests nor otherwise renders obvious the invention claimed by Applicants. Applicants therefore submit that the outstanding Section 102(a) rejection of claims 1, 2, 6 and 7 is improper and should be withdrawn.

At page 7, section 12, of the Office Action, the Examiner rejected claims 3 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Leymann in view of U.S. Patent No. 6,633,908 (Maccabee et al., "Maccabee"). Such rejection is respectfully traversed.

Notwithstanding what Maccabee may or may not disclose in relation to Applicants' claims 3 and 8, that patent teaches directly away from independent claims 1 and 6 from which they depend. More particularly, Maccabee proposes the creation of a transaction definition language called the ETE (End-to-End) Transaction Definition Language that specifies how to construct identifiable transactions from events and links. In an illustrated example, the ETE Transaction Definition Language provided in Maccabee requires the creation of twenty-one (21) lines of software code merely to define something as relatively simple as a Web commerce transaction. Merely contemplating all of the possible events and transactions that might be involved in a complex business transaction, particularly one whose execution involves the coordination of several business entities and computer systems, is itself a daunting task. Codifying these items complicates the task. That is, individually defining all of these events and transactions in software code in order to produce a complete set of transaction generation rules amounts to a potentially vast amount of preliminary preparation activity that must be performed before the monitoring system may be placed into operation.

The present invention requires no predefinition of events and thereby avoids the disadvantages of the Maccabee system. This beneficial feature is present in each of independent claims 1, 6 and 9. The pertinent passage from claim 1 is representative:

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> <u>without predefining events describing the potential
> stages of a transaction to be executed by said
> computer application</u>, adding software code to said
> computer application for assigning a single general
> reference to characteristic transactional information
> associated with said transaction

Maccabee is therefore in direct conflict with an essential feature of each Applicants' independent claims. Accordingly, since Maccabee leads one directly away from the invention prescribed in those claims, it necessary also leads one directly away from the invention defined by their dependent claims, including claims 3 and 8. As a result, since no combination of the teachings of Leymann and Maccabee can produce Applicants invention as defined by independent claims 1 and 6, the Leymann-Maccabee reference tandem likewise cannot render obvious dependent claims 3 and 8.

At page 9, section 15, of the Office Action, the Examiner rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Leymann in view of Maccabee. Such rejection is respectfully traversed.

Like independent claims 1 and 6, independent claim 9 mandates that the single general reference to characteristic transactional information be assigned <u>without predefining events describing the potential stages of the transaction</u>. Again, Maccabee does just the opposite. And, recall that Leymann provides a separate application invocation agent for assigning references to transactional information as opposed adding software to the application under scrutiny for that purpose.

Thus, no possible combination of the teachings of Leymann and Maccabee can render obvious amended independent claim 9. Withdrawal of the outstanding Section 103(a) rejection of claim 9 is therefore respectfully requested.

At page 11, section 16, of the Office Action, the Examiner rejected claims 4, 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Leymann and Maccabee in view of "Official Notice." Likewise at page 12, section 18, of the Office Action, the Examiner rejected claims 5 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Leymann and Maccabee in view of "Official Notice." Such rejections are respectfully traversed.

As repeatedly noted above, the teachings of Leymann and Maccabee cannot be combined in any way to so as to anticipate or render obvious independent claims 1, 6 and 9. As a matter of law, therefore, Leymann and Maccabee cannot be relied upon to reject the claims that depend therefrom, including claims 4, 5, 10, 11 and 12 -- notwithstanding the Examiner's invocation of "Official Notice" in connection with those claims (which "Official Notice" Applicants nevertheless do not concede).

Accordingly, withdrawal of the outstanding Section 103(a) rejection of claims 4, 5, 10, 11 and 12 is respectfully requested.

Lastly, Applicants disagree with the Examiner's statements in the "Conclusion" section of the Office Action (page 14, section 20) to the effect that claims 1, 6 and 9 "are too vague"

because they do not contain certain feature set out in a number of the dependent claims. To the extent these statements may be requirements or simply invitations to incorporate the features mentioned by the Examiner into the independent claims, Applicants' respectfully decline to adopt these proposals. Claims 1, 6 and 9 are complete in and of their own right and, pursuant to the strictures of 35 U.S.C. §112, second paragraph, they particularly point out and distinctly claim the subject matter which Applicants regard as their invention.

In view of the foregoing, the instant application is believed to be in condition for allowance and, therefore, early issuance thereof is earnestly solicited.

If the Examiner believes that a telephone interview would be beneficial to advance prosecution of the present application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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